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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/083,485

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Gonzalez Parada Adrian

4792

31667

7590

03/21/2003

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EXAMINER

NGUYEN, CHAU N

ART UNIT

PAPER NUMBER

2831

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/083,485

Applicant(s)

ADRIAN ET AL.

Examiner

Chau N Nguyen

Art Unit

2831

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: the specification does not provide proper antecedent basis for the claimed subject matter of  $P_{\max 1}$  (1000 cm),  $P_{\max 2}$  (1000 cm),  $P_{\min 1}$  (2 cm),  $P_{\min 2}$  (2 cm),  $\alpha_{\max 1}$  (45 degrees),  $\alpha_{\min 1}$  (0 degrees),  $\alpha_{\max 2}$  (45 degrees), and  $\alpha_{\min 2}$  (0 degrees).

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claim 15 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification does not provide

support for the claimed subject matter of "the tubular core consisting of a first layer of copper tapes" as claimed in claim 15.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12, lines 12-18, the recitation of "one section of a layer of the superconducting tapes positioned next to the central core being wound in one direction opposite the other section of said superconducting layers wound on top of said other layers closest to said layer of said copper tape, wherein a laying length of all the layers varies from a maximum  $P_{\max 1}$  (1000 cm) and  $P_{\max 2}$  (1000 cm) in the intermediate layers and a  $P_{\min 1}$  (2 cm) and  $P_{\min 2}$  (2 cm) in the external layers, while the laying angle of the tapes in all of the layers varies from  $\alpha_{\max 1}$  (45 degrees) to  $\alpha_{\min 1}$  (0 degrees) and from  $\alpha_{\max 2}$  (45 degrees) to  $\alpha_{\min 2}$  (0 degrees)" is unclear and causes confusion. For example, "one section....next to the central core being wound in one direction opposite the other section....closest to the layer of the copper tape" is vague since the copper tape is next to the central core. What is it

mean by varying from 1000 cm and 1000 cm and from 2 cm and 2 cm? The claim recites "the intermediate layers" and "the external layers" but no "internal (or inner most) layers". Moreover, the limitations in the parentheses are vague since it is unclear that the limitations are positively claimed.

Claim 12, line 16, change "and", first occurrence, to --to--.

Claim 12, lines 20 and 21, "the layer" and "each cable layer" are unclear to which layer that has been earlier recited.

Claim 13, line 1, "said tube element" lacks antecedent basis.

Claim 14, line 1, change "tapes" to --tape--.

Claim 14, line 2, change "have" to --has--.

Claim 14, line 4, change "as" to --has--.

Claim 14, lines 4-5, delete "and the second layer of stainless steel tape having a width ranging from about 2.5 to about 4 cm".

Claim 15, line 2, "the tubular core" lacks antecedent basis.

Claim 17, line 2, "the conductor layers" lacks antecedent basis.

Claim 17, line 2, "and/or" is vague and should be changed to either --or-- or --and--.

Claim 18, line 2, "the layers are made of one or several superconducting tapes" is vague since claim 12 recites "a plurality of superconducting tapes", and "the layers" is not clear to which layers.

Claim 19, lines 2-3, "a ratio of the number of layers placed in opposite direction is between 1:1 and 1:2" is vague. Should it be --a ratio of the number of layers placed in opposite direction and...(other element) is between 1:1 and 1:2--.

Claim 20, line 2, "the superconducting elements" lacks antecedent basis.

The above are but a few specific examples of indefinite and functional or operational language used throughout this claim, and are only intended to illustrate the extensive revision required to overcome the rejection under 35USC 112, second paragraph. The above mentioned corrections therefore, are in no way a complete and thorough listing of every indefinite and functional or operational language used throughout this claim. Applicant is required to revise all of the claim completely, and not just correct the indefinite and functional or operational languages mentioned.

No rejection based on prior art is given at this point of prosecution. MPEP 2173.06 states:

*"...where there is a great deal of confusion and uncertainty as to the proper interpretation of the limitations of a claim, it would not be proper to reject such a claim on the basis of prior art. As*

*stated in In re Steele, 305 F.2d 859, 134 USPQ 292 (CCPA 1962), a rejection under 35 USC 103 should not be based on considerable speculation about the meaning of terms employed in a claim or assumptions that must be made as to the scope of the claims."*

Given the great arrangement of confusion and uncertainty as to the proper interpretation of the limitations of claims, it would not be proper to reject claims 12-20 on the basis of prior art.

#### ***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chau N Nguyen whose telephone number is 308-0693. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dean Reichard can be reached on (703) 308 3682. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305 3432 for regular communications and (703) 305 1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

Application/Control Number: 10/083,485  
Art Unit: 2831

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A handwritten signature in black ink, appearing to read "Chau N Nguyen", with a long horizontal flourish extending to the right.

Chau N Nguyen  
Primary Examiner  
Art Unit 2831

CN  
March 20, 2003